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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,222	07/01/2005	Soichiro Kawakami	03500.000345.	4982
5514 7590 06/24/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
HAN, KWANG S				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,222

Applicant(s)

KAWAKAMI ET AL.

Examiner

Kwang Han

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-9 and 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

**ELECTRODE MATERIAL FOR LITHIUM SECONDARY BATTERY AND ELECTRODE
STRUCTURE HAVING THE ELECTRODE MATERIAL**

Examiner: K. Han SN: 10/541,222 Art Unit: 1795 June 24, 2009

Detailed Action

1. The Applicant's amendment filed on April 7, 2009 was received. Claims 2, 4, and 6 were cancelled. Claim 1 was amended.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1-8 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Idota et al. (US 6235427).

Regarding claim 1, Idota is directed towards an electrode material for a lithium secondary battery comprised of particles of a solid state silicon alloy having an amorphous material (2:13-25) including alkaline earth metals, transitions metals, or semi-metals (1:47-60; 3:4-20) composed of silicon and two or more elements including tin, gallium, aluminum, silver, zinc, and titanium (3:16-27), a ratio of the alloying metals other than silicon to be between 5 to 2000% by weight (3:21-27), and where the solid state alloy is a solid solution (3:9-10) with the alloy undergoing reactions on cooling (3:12-14). The alloy would inherently be mixed in a melted liquid state (single liquid phase) before the cooling occurs. A reference which is silent about a claimed

invention's features is inherently anticipatory if the missing feature *is necessarily present in that which is described in the reference*. In re Robertson, 49 USPQ2d 1949 (1999).

Regarding claim 5, Idota discloses an alloy composed of silicon and two or more elements including tin, gallium, aluminum, silver, zinc, and titanium (3:16-27).

Regarding claims 7 and 8, Idota discloses the alloy containing a eutectic including eutectics formed from silicon and an element selected from tin, gallium, aluminum, silver, zinc, and titanium (3:4-27).

Regarding claim 13, Idota discloses particles of the silicon alloy having a preferable average particle diameter range of 0.001 to 5 μm .

Regarding claim 14, Idota discloses the particles of the alloy having the form of fine powder (3:25-38).

Regarding claims 15 and 17, Idota discloses the material for the electrode comprised of a mixture of silicon alloy and a carbonaceous material which is employed as a conducting agent (7:49-53).

Regarding claim 16, Idota discloses an electrode structure which includes a conductive agent, a binder, and a current collector (2:3-13).

Regarding claim 18, Idota discloses a positive electrode active material capable of intercalating and deintercalating lithium and the negative electrode material capable of intercalating and deintercalating lithium (1:50-60). A reference which is silent about a claimed invention's features is inherently anticipatory if the missing feature *is necessarily present in that which is described in the reference*. In re Robertson, 49 USPQ2d 1949 (1999).

Claim Rejections - 35 USC § 103

4. Claims 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Idota et al. as applied to claim 1 above, and further in view of Suzuki et al. (US 2002/0146623).

Regarding claims 9, 11, and 12, the teachings of Idota as discussed above are herein incorporated. Idota is silent as to the electrode material being doped with boron.

Suzuki teaches a lithium secondary battery with a silicon material electrode which contains doped boron [0069] in the amount of 0.1 to 50 wt. % (0.1 wt% silicon would have an atomic ratio of approximately 0.0026 relative to silicon) for the benefit of providing improved capacity loss and fine cycle properties while retaining a large discharge capacity [0015, 0016]. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a silicon based electrode which contains doped boron for lithium secondary material because Suzuki teaches it provides for improved capacity loss and fine cycle properties while retaining a large discharge capacity.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Idota et al. as applied to claim 18 above and further in view of Nakanishi et al. (WO 2001/41249 using US 6723472 for translation and citation).

Regarding claim 19, the teachings of Idota as discussed above are herein incorporated. Idota discloses the positive electrode being a lithium-transition metal

complex oxide (Abstract) but is silent towards this material comprising yttrium or yttrium and zirconium.

Nakanishi teaches a lithium secondary battery which positive electrode materials containing elements from Groups IIIB and IVB of the periodic table (i.e. yttrium, zirconium) for the benefit of forming a battery with high rate and low-temperature characteristics because addition of these elements causes change in the surface state of the active material to increase the surface area (1:50-59; 5:10-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to use elements including yttrium and zirconium in the positive electrode because Nakanishi teaches it provides positive electrodes for batteries having high-rate and low-temperature characteristics.

Response to Arguments

6. Applicant's arguments filed April 7, 2009 have been fully considered but they are not persuasive.

Applicant's principal arguments are:

- (a) the Idota reference does not teach a microcrystal or amorphous material comprising an element other than silicon dispersed in the microcrystalline silicon or amorphized silicon,*
- (b) even if the alloys were melted, there is no guarantee that the alloy would be completely mixed.*

In response to Applicant's arguments, please consider the following comments:

(a) Idota discloses that the silicic material used for the negative electrode may be amorphous (2:13-25),

(b) melted alloys are affected by convective currents within the melt which would inherently provide the mechanism for mixing of the melted alloys. It is also well known and obvious to one of ordinary skill in the art to provide a mixed alloy which is homogeneous in composition for the benefit of consistent properties throughout.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact/Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwang Han whose telephone number is (571) 270-5264. The examiner can normally be reached on Monday through Friday 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan can be reached on (571) 272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. H./
Examiner, Art Unit 1795

/Dah-Wei D. Yuan/
Supervisory Patent Examiner, Art Unit 1795